

**REMARKS**

This Reply is in response to the Official Action dated August 9, 2004. Claims 1-25 are pending in the above-referenced patent application. Claims 1-4 and 11-13 were rejected under 35 U.S.C. 102(e) as being anticipated by USPN 5,886,731 to Ebisawa. Claims 5-10, 14 and 18-25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ebisawa in view of USPN 6,177,931 to Alexander et al. ("Alexander). Disposition of Claims 15-17 is unclear as the Patent Office as not provided arguments for rejection of Claims 15-17. As such, Applicant is unable to respond to rejection of Claims 15-17, until such arguments are provided.

**Rejection of Claims 1-4 and 11-13 under 35 U.S.C. 102(e)**

Rejection of Claims 1-4 and 11-13 under 35 U.S.C. 102(e) as being anticipated by Ebisawa is respectfully traversed because Ebisawa does not disclose all of the claimed limitations.

**As per Claim 1**, Ebisawa does not disclose means for providing a digital signal, the digital signal having information reflective of at least one regular program and at least one Background Commercial. In the present invention, Background Commercials differ from typical commercial advertisements in Ebisawa because a typical commercial advertisement is located between or in the middle of regular non-commercial programs. Whereas, Background Commercials herein can be available anytime, even when a regular program is displaying, i.e., the Background Commercials are carried in the background of the regular (non-commercial) programming. Ebisawa does not disclose a digital signal

having information reflective of at least one regular program and at least one Background Commercial.

Further, Ebisawa does not disclose selection means for allowing the end user to select between the at least one regular program and the at least one Background Commercial (BS) for display on the presentation unit, as claimed herein. In Ebisawa, FIGS. 2 and 4 and corresponding description relied on by the Patent Office, the user only selects the programming and commercial mix to be transmitted from the transmitter 100 to the receiver 200. This selection information is sent from the receiver 200 to the transmitter 100. Based on that selection information, the programming/commercial mix is put together in the transmitter 100, then sent from the transmitter 100 to the receiver 200 in a pre-formatted manner. By contrast, as required by Claim 1, the regular programming and Background Commercial mix is put together at the receiver based on user selection at the receiver. In other words, the regular programming and Background Commercial signals are sent from the transmitter to the receiver, and the receiver utilizes user selection to put together a selected programming/commercial mix for display to the user.

Further, unlike Ebisawa, the return channel in the claimed invention is configured to communicate Commercial Viewing Data from the receiver to a digital service operator, not commercial selection data for determining a programming commercial mix at the transmitter as in Ebisawa.

**As per Claim 2**, Ebisawa does not disclose that the information reflective of the at least one Background Commercial contains Audio-Visual Information and/or Banner Information, the Banner Information being presented to the presentation unit with the at least one regular program. As discussed in relation to Claim 1, Ebisawa does not even disclose Background Commercials as claimed. Further, on page 7, of the Office Action, the Patent Office admits that Ebisawa does not disclose Banner Information.

**As per Claim 3**, Ebisawa does not disclose a control switch whereby the user can filter the Background Commercial portion of the digital signal from being delivered to the presentation unit, as claimed. The unit 301 in Ebisawa is to select whether any commercials are sent to the receiver 200 from the transmitter 100 to begin with, and not to filter Background Commercials received at the receiver from the display monitor as claimed herein. In Ebisawa, once commercials are received at the receiver 200, they are displayed (they cannot be filtered).

**As per Claim 4**, Ebisawa does not disclose means for communicating the Background Commercial Viewing Data over the return channel from the receiver to the service operator, as claimed. The return channel in the claimed invention is configured to communicate Commercial Viewing Data from the receiver to a digital service operator, not commercial selection data for determining a programming commercial mix at the transmitter as in Ebisawa. Further, Ebisawa does not disclose means for updating a Background Commercial Viewing Record with the Background Commercial Viewing Data communicated from the receiver to the digital service operator, as claimed.

**As per Claim 11**, Ebisawa does not disclose creating a combined digital television signal which combines information reflective of regular programming and Background Commercials. As discussed, Ebisawa does not even disclose a digital signal that includes Background Commercials. Nor does Ebisawa disclose that the information reflective of the Background Commercials containing Audio-Visual Information and/or Banner Information, as claimed. Therefore, clearly, Ebisawa does not disclose selecting a selected portion of the combined digital signal from the information reflective of the regular programming and the Background Commercials for display at a presentation unit, as claimed. Further, in Ebisawa, the user selects the programming and commercial mix to be transmitted from the transmitter 100 to the receiver 200. This selection information is first sent from the receiver 200 to the transmitter 10. Thereafter, based on that selection information, the programming/commercial mix is put together in the transmitter 100, then sent from the transmitter 100 to the receiver 200 in a pre-formatted manner. By contrast, as required by Claim 11, at the receiver the user selects a selected portion of the combined digital signal from the information reflective of the regular programming and the Background Commercials for display at a presentation unit.

**As per Claim 12**, Ebisawa does not disclose creating Background Commercial Viewing Data and communicating the Background Commercial Viewing Data over the return channel from the receiver to the service operator, as claimed. The return channel in the claimed invention is configured to communicate Commercial Viewing Data from the receiver to a digital service operator, not commercial selection data for determining a

programming commercial mix at the transmitter as in Ebisawa. Further, Ebisawa does not disclose means for updating a Background Commercial Viewing Record with the Background Commercial Viewing Data communicated from the receiver to the digital service operator, as claimed.

**As per Claim 13**, as Ebisawa does not disclose creating Background Commercial Viewing Data and communicating the Background Commercial Viewing Data over the return channel from the receiver to the service operator (Claim 12), then Ebisawa does not disclose the steps of determining an economic benefit based upon the updated a Background Commercial Viewing Record. Nor does Ebisawa disclose providing that economic benefit to the end user.

**Rejection of Claims 5-10, 14 and 18-25 under 35 U.S.C. 103(a)**

Rejection of Claims 5-10, 14 and 18-25 under 35 U.S.C. 103(a) as being unpatentable over Ebisawa in view of Alexander, is respectfully traversed because the references, alone or in combination, do not disclose all of the claimed limitations.

**As per Claim 5**, as discussed in relation to Claim 1, Ebisawa does not disclose means for providing a digital signal, the digital signal having information reflective of at least one regular program and at least one Background Commercial. Further, Ebisawa does not disclose a receiver for receiving the digital signal and a presentation unit for displaying at least a portion of the digital signal which includes the Background Commercial and a regular program. As the Patent Office also states, Ebisawa does not

disclose Banner Information in Background Commercials, being presented to the presentation unit with the at least one regular program. However, the Patent Office states that Alexander discloses Banner Information as claimed. Alexander is directed to an improvement over previous Electronic Programming Guides ("EPG").

In col. 32, lines 35-60 (relied on by the Patent Office), Alexander simply mentions scheduling of telecast advertisements that are viewable during the telecast of the television program that the viewer is watching. One example is customizing an overlay message to an advertisement on a local geographic basis. The customized messages are preloaded into the memories of particular viewers' EPG's. The preloaded messages can be transmitted by a head end during off hours and stored in the viewer's terminal for use when the advertisement runs. The electronic trigger to run the message can be transmitted along with the television signal in and can identify the messages stored in the user terminal that need to be applied.

The customized messages in Alexander are preloaded for later display. Neither Ebisawa nor Alexander (alone or in combination) disclose a digital signal having information reflective of at least one regular program and at least one Background Commercial, wherein the information reflective of the at least one Background Commercial contains Banner Information, as claimed herein. Ebisawa only discloses regular commercials, not Background Commercials as claimed. Further, unlike the Background commercials claimed herein, in Ebisawa the commercials are inserted in between regular programming. In Alexander, unlike the digital signal claimed herein, the

signals do not include Background Commercial and regular programming. The customized messages in Alexander are preloaded for later display, rather than simulcast with regular programming for display thereon. Further, neither Ebisawa nor Alexander (alone or in combination) disclose a receiver for receiving the digital signal and a presentation unit for displaying at least a portion of the digital signal, the Banner Information being presented to the presentation unit with the at least one regular program.

Further, there is no motivation suggested by either reference to combine them. It is well settled that in order for a modification or combination of the prior art to be valid, the prior art itself must suggest the modification or combination, "...invention cannot be found obvious unless there was some explicit teaching or suggestion in the art to motivate one of ordinary skill to combine elements so as to create the same invention." *Winner International Royalty Corp. v. Wang*, No. 96-2107, 48 USPQ.2d 1139, 1140 (D.C.D.C. 1998) (emphasis added). "The prior art must provide one of ordinary skill in the art the motivation to make the proposed molecular modifications needed to arrive at the claimed compound." *In re Jones*, 958 F.2d 347, 21 USPQ.2d 1941, 1944 (Fed. Cir. 1992) (emphasis added). Neither of the references suggests the motivation to modify or combine the references as proposed. The references are individually complete and functionally independent for their limited specific purposes and there would be no reason to make the modification proposed by the Patent Office. Therefore, because neither of the prior art references suggests the combination and modifications proposed by the Patent Office the combination and modifications are improper.

Even if the modification was legally justified, it still would not render Applicant's claimed invention obvious. The Patent Office admits that Ebisawa does not teach all limitations in Claim 5. Therefore, the Patent Office attempts to modify Ebisawa in order to teach Applicant's claimed invention. However, as discussed, there is no teaching in the references of the claimed limitations. There is no need in Ebisawa for Banner Information as claimed, because regular commercials are inserted between programs. The effort required to combine the teachings of the references would require a substantial undertaking and numerous elements which would not be obvious.

Further, Applicant respectfully submits that the Patent is improperly using "hindsight" and the teachings of Applicant's own claimed invention in order to combine references to render Applicant's claims obvious. The Office Action admits that Ebisawa fails to teach all of the limitations of Applicant's claimed invention. However, the Office Action improperly attempts to modify Ebisawa using Alexander (which also fails to teach all of the limitations of Applicant's claimed invention), in an attempt to achieve Applicant's claimed invention.

**As per Claim 6**, Ebisawa does not disclose selection means for allowing the end user to select between the at least one regular program and the at least one Background Commercial for display on the presentation unit, as claimed herein. In Ebisawa, FIGS. 2 and 4 relied on by the Patent Office, the user selects the programming and commercial mix to be transmitted from the transmitter to the receiver. This selection information is sent from the receiver to the transmitter via a telephone line. Based on that section



information, the programming/commercial mix is put together in the transmitter, then sent from the transmitter to the receiver in a pre-formatted manner. By contrast, as required by Claim 1, the regular programming and Background Commercial mix is put together at the receiver based on user selection at the receiver. In other words, the regular programming and Background Commercial signals are sent from the transmitter to the receiver, and the receiver utilizes user selection to put together a selected programming/commercial mix for display to the user.

**As per Claim 7**, unlike Ebisawa, the return channel in the claimed invention is configured to communicate Commercial Viewing Data from the receiver to a digital service operator, not commercial selection data for determining a programming commercial mix at the transmitter as in Ebisawa.

**As per Claim 8**, Ebisawa does not disclose that the information reflective of the at least one Background Commercial contains Audio-Visual Information and/or Banner Information, the Banner Information being presented to the presentation unit with the at least one regular program. As discussed, neither Ebisawa nor Alexander discloses Background Commercials transmitted and displayed as claimed.

**As per Claim 9**, Ebisawa does not disclose a control switch whereby the user can filter the Background Commercial portion of the digital signal from being delivered to the presentation unit, as claimed. The unit 301 in Ebisawa is to select whether any commercials are sent to the receiver 200 from the transmitter 100 to begin with, and not

to filter Background Commercials received at the receiver from the display monitor as claimed herein. In Ebisawa, once commercials are received at the receiver 200, they are displayed (they cannot be filtered).

**As per Claim 10**, Ebisawa does not disclose means for communicating the Background Commercial Viewing Data over the return channel from the receiver to the service operator, as claimed. The return channel in the claimed invention is configured to communicate Commercial Viewing Data from the receiver to a digital service operator, not commercial selection data for determining a programming commercial mix at the transmitter as in Ebisawa. Further, Ebisawa does not disclose means for updating a Background Commercial Viewing Record with the Background Commercial Viewing Data communicated from the receiver to the digital service operator, as claimed.

**As per Claim 14**, as discussed Ebisawa and/or Alexander does not disclose limitations of base Claim 11. Further, the customized messages in Alexander are preloaded for later display. Neither Ebisawa nor Alexander (alone or in combination) discloses a digital signal having information reflective of at least one regular program and at least one Background Commercial, wherein the information reflective of the at least one Background Commercial contains Banner Information, as claimed herein. Ebisawa only discloses regular commercials, not Background Commercials as claimed. Further, unlike the Background commercials claimed herein, in Ebisawa the commercials are inserted in between regular programming. In Alexander, unlike the digital signal claimed herein, the signals do not include Background Commercial and regular programming.

The customized messages in Alexander are preloaded for later display, rather than simulcast with regular programming for display thereon. Further, neither Ebisawa nor Alexander (alone or in combination) discloses a receiver for receiving the digital signal and a presentation unit for displaying at least a portion of the digital signal, the Banner Information being presented to the presentation unit with the at least one regular program.

**As per Claim 18**, as discussed in relation to Claim 1, Ebisawa does not disclose means for receiving a digital signal, the digital signal having information reflective of a regular program and at least one Background Commercial (BC), wherein the information reflective of the at least one Background Commercial contains Audio-Visual Information and Banner Information, as claimed. As such, nor does Ebisawa disclose: (a) means for decoding the digital signal and providing a first signal reflective of the regular program and a second signal reflective of the at least one Background Commercial, (b) means for receiving the second signal reflective of the at least one Background Commercial and providing a second BC signal reflective of Audio-Visual Information related to the one of the at least one Background Commercials, or (c) means for providing a video output signal, the means for providing the video output signal combining information from one of the signal reflective of the regular program or the second BC signal, with information from the signal reflective of the Banner Information.

As the Patent Office also states, Ebisawa does not disclose Background Commercials containing banner information, a first BC signal reflective of the Banner Information related to one of the at least one Background Commercials and combining

information from the second BC signal with information from the signal reflective of the Background Commercials. However, the Patent Office states that Alexander discloses such limitations.

In col. 32, lines 35-60 (relied on by the Patent Office), Alexander simply mentions scheduling of telecast advertisements that are viewable during the telecast of the television program that the viewer is watching. One example is customizing an overlay message to an advertisement on a local geographic basis. The customized messages are preloaded into the memories of particular viewers' EPG's. The preloaded messages can be transmitted by a head end during off hours and stored in the viewer's terminal for use when the advertisement runs. The electronic trigger to run the message can be transmitted along with the television signal in and can identify the messages stored in the user terminal that need to be applied.

The customized messages in Alexander are preloaded for later display. Neither Ebisawa nor Alexander (alone or in combination) disclose a digital signal having information reflective of at least one regular program and at least one Background Commercial, wherein the information reflective of the at least one Background Commercial contains Banner Information, as claimed herein. Ebisawa only discloses regular commercials, not Background Commercials as claimed. Further, unlike the Background commercials claimed herein, in Ebisawa the commercials are inserted in between regular programming. In Alexander, unlike the digital signal claimed herein, the signals do not include Background Commercial and regular programming. The

customized messages in Alexander are preloaded for later display, rather than simulcast with regular programming for display thereon. Further, neither Ebisawa nor Alexander (alone or in combination) disclose a receiver for receiving the digital signal and a presentation unit for displaying at least a portion of the digital signal, the Banner Information being presented to the presentation unit with the at least one regular program.

Further, in Alexander col. 32, lines 55-60 (relied on by the Patent Office), Alexander only mentions that in another embodiment the customized messages are narrowcast with the televised advertisement. One way to narrowcast the customized messages is to embed the customized information in the advertisement video stream. Another way is to transmit a digital "watermark" in the video stream of the advertisement.

As such, there is no disclosure in Alexander of a digital signal that includes regular programming and Background Commercials as claimed. Alexander only discloses embedding customized messages with advertisements, not a digital signal that includes regular programming and Background Commercials as claimed. There are no first and second BS signals in Ebisawa or Alexander (alone or in combination), as claimed. Nor is there any disclosure in Ebisawa or Alexander (alone or in combination) to combine two BC signals. Ebisawa or Alexander do not disclose a BC signal, as claimed. Alexander does not disclose multiple BS signals with a regular program as claimed.

Further, there is no motivation suggested by either reference to combine them. It is well settled that in order for a modification or combination of the prior art to be valid, the prior art itself must suggest the modification or combination, "...invention cannot be found obvious unless there was some **explicit** teaching or suggestion in the art to motivate one of ordinary skill to combine elements so as to create the same invention." *Winner International Royalty Corp. v. Wang*, No. 96-2107, 48 USPQ.2d 1139, 1140 (D.C.D.C. 1998) (emphasis added). "The prior art **must provide** one of ordinary skill in the art the **motivation** to make the proposed molecular modifications needed to arrive at the claimed compound." *In re Jones*, 958 F.2d 347, 21 USPQ.2d 1941, 1944 (Fed. Cir. 1992) (emphasis added). Neither of the references suggests the motivation to modify or combine the references as proposed. The references are individually complete and functionally independent for their limited specific purposes and there would be no reason to make the modification proposed by the Patent Office. Therefore, because neither of the prior art references suggests the combination and modifications proposed by the Patent Office the combination and modifications are improper.

Even if the modification was legally justified, it still would not render Applicant's claimed invention obvious. The Patent Office admits that Ebisawa does not teach all limitations in Claim 5. Therefore, the Patent Office attempts to modify Ebisawa in order to teach Applicant's claimed invention. However, as discussed, there is no teaching in the references of the claimed limitations. There is no need in Ebisawa for Banner Information as claimed, because regular commercials are inserted between programs.

The effort required to combine the teachings of the references would require a substantial undertaking and numerous elements which would not be obvious.

Further, Applicant respectfully submits that the Patent is improperly using “hindsight” and the teachings of Applicant’s own claimed invention in order to combine references to render Applicant’s claims obvious. The Office Action admits that Ebisawa fails to teach all of the limitations of Applicant’s claimed invention. However, the Office Action improperly attempts to modify Ebisawa using Alexander (which also fails to teach all of the limitations of Applicant’s claimed invention), in an attempt to achieve Applicant’s claimed invention.

**As per Claim 19**, as discussed the references, alone or in combination, do not disclose the limitations of base Claim 18. Further, the references, alone or in combination, do not disclose means for receiving the signal reflective of the at least one Background Commercial provides a third BC signal reflective of information identifying the one of the at least one Background Commercials. The Patent Office has not shown where such limitations are disclosed in Ebisawa or Alexander. The Patent Office only states that such limitations are “encompassed” in the references, but does not explain where and how. If the claims are once again rejected, Applicant respectfully requests the Patent Office to specifically point to such teachings in the references. As stated, the commercials in Ebisawa are not Background Commercials, as claimed. Inserting ads in Ebisawa has nothing to do with displaying Background Commercials with regular

programming as claimed. There are no multiple BC signals disclosed in Ebisawa, as claimed.

**As per Claim 20**, the references, alone or in combination, do not disclose a selection means for allowing an end user to select between information from the signal reflective of the regular program and information from the second BC signal for inclusion in the video output signal. The selection means 203 in Ebisawa has nothing to do with selecting a BC signal, as claimed because as discussed inserting ads in Ebisawa has nothing to do with displaying Background Commercials with regular programming as claimed.

**As per Claim 21**, the references, alone or in combination, do not disclose a User Interface means for obtaining User commands to enable or disable the inclusion of Banner Information and/or the second BC signal in the video output signal and a control unit for providing control signals reflective of the User commands. As discussed, neither Ebisawa nor Alexander discloses BC signals or Banner Information as claimed. Further, neither reference discloses a receiver that provides such capabilities. Nor are there multiple BS signals disclosed by the references alone or in combination.

**As per Claim 22**, there is no storage means in Ebisawa for storing Background Commercial view data and a transmission means for providing a return signal reflective of the Background Commercial view data. Further, unlike Ebisawa, the return channel in the claimed invention is configured to communicate Commercial Viewing Data from the,



not commercial selection data for determining a programming commercial mix at the transmitter as in Ebisawa.

**As per Claim 23**, in Ebisawa there is no storage means for storing information from a second BC signal, because as discussed no BC signals are disclosed in Ebisawa. As such, Ebisawa does not disclose means for replaying the second BC signal stored in the storage means to the means for providing a video output signal for inclusion in the video output signal.

**As per Claim 24**, in Ebisawa there is no storage means for storing information from any BC signal, because as discussed no BC signals are disclosed in Ebisawa. Ebisawa does not disclose a storage means for storing information from a second BC signal. Nor is there any disclosure in Ebisawa about means for replaying a BC signal stored in the storage means to the means for providing a video output signal for inclusion in the video output signal. Ebisawa only inserts commercials between programming, not Background Commercials (BC), as claimed herein. Indeed, as noted above, Ebisawa does not disclose BC signals along with regular programming signals in a digital signal. As such, Ebisawa does not disclose that there is information reflective of a plurality of Background Commercials within the digital signal, wherein the second BC signal stored in the storage means is related to the plurality of the Background Commercials, as claimed. Nor does Ebisawa mention that the means for replaying provides one or several of the stored plurality of Background Commercials for inclusion in the video output.

**As per Claim 25**, Ebisawa only inserts commercials between programming, not Background Commercials (BC), as claimed herein. Indeed, as noted above, Ebisawa does not disclose BC signals along with regular programming signals in a digital signal. Further, Ebisawa does not disclose a storage means for storing information from the signal reflective of the regular program, and means for replaying the signal reflective of the regular program stored in the storage means to the means for providing a video output signal for inclusion in the video output signal.

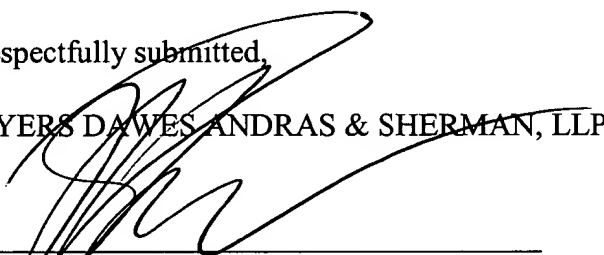
**Conclusion**

For these, and other, reasons, Applicants believe that the claims are in condition for allowance. Reconsideration, re-examination, and allowance of all claims are respectfully requested.

If necessary, the Commissioner is hereby authorized to charge payment or credit any overpayment to Deposit Account No. 01-1960 for any additional fees required in connection with this filing.

Respectfully submitted,

MYERS DAWES ANDRAS & SHERMAN, LLP



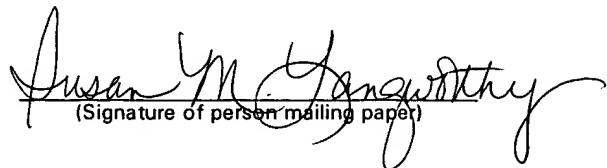
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